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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/874,314	06/06/2001	Tsuyoshi Inoue	Q64575	6107

7590 09/20/2006

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Washington, DC 20037

EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 09/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/874,314

Applicant(s)

INOUE ET AL.

Examiner

Daniel Zirker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/19/05 & 3/27/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. The Examiner notes that the application and its RCE filing dated December 19, 2005 have been revived from the earlier holding of Abandonment (Petition dated March 17, 2006) and the application is now properly pending following its revival as stated in the Petition decision dated March 27, 2006. Claims 1-6 are pending.

3. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dobashi et al taken in view of EP '585. With respect to claims 1,2,5 and 6, all of which either specifically require (claims 5,6) or that the Examiner has chosen to elect (Claims 1,2) from a two member Markush grouping the presence of the tackifier "hydrogenated aliphatic/aromatic copolymer petroleum resins", little needs to be stated beyond the fact that the Examiner relies on the earlier affirmance by the BPAI of his decision to finally reject claims 1 and 2 as unpatentable over the prior art combination of record.

Additionally, with respect to the "styrene/hydrogenated terpene copolymer resin" tackifier of claims 3 and 4 (as well as the Markush Group of claims 1 and 2) the Examiner notes that EP '585 also teaches on page 3, lines 5-10, particularly lines 8-10, the presence of this first tackifier member of applicants' Markush grouping, as well as the previously relied upon second member. Note particularly the sentence "...resins made by the copolymerization of pure aromatic monomers (e.g. styrene.....) with....polyterpenes or derivatives thereof". Note also that hydrogenation of this tackifier compound would, as in the case of applicants' second Markush member, be inherent. The Examiner does, however, take note that several of applicants' arguments

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in his submitted Response deserve consideration. It is first noted that as regards applicants' arguments (Response, page 6) concerning the claimed amounts of tackifier present in the adhesive composition, none of the three independent claims (1,3,5) pending require any specific amount of tackifier to be present. As to the three dependent claims, however, the range of weight % amounts of tackifier used by the Dobashi et al adhesive clearly encompass the claimed range (0.2 to 5 part by weight per 100 parts of rubbery polymer). Additionally, applicants' remarks (Response, page 7) regarding the Comparison in the specification against adhesive systems (Comparative Examples 1 and 2) that have no tackifier are simply irrelevant, and it must also be noted that it is well known in the pressure sensitive adhesive art that tackifiers, (as the name implies) are a primary source of the tack or quick stick that rubber based pressure sensitive adhesive exhibit. As regards the apparent sole meaningful comparative example in the specification, Comparative Example 3 (Response, pages 9-10) it is again noted that the Comparison of this sole Example is directed to a vaguely described presence or absence (how is this term measured?) of "fouling", which the Examiner believes is clearly inadequate to rebut the **prima facie** case as previously set forth. Finally, as discussed by the Board, the Inoue 132 Declaration is also ineffective to prove unexpected results for either of the tackifiers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is 571-272-1486. The examiner can normally be reached on Monday - Thursday from 8:30 to 6:00. The examiner can also be reached on alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on 571 - 272 - 1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel Zirker
Primary Examiner
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A handwritten signature in black ink that reads "Daniel Zirker". The signature is written in a cursive, flowing style.